

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
--------------------	-------------	-----------------------	---------------------

08/213,991 03/22/94 O'BRIEN

D 7165-27

LM21/0121  
PANITCH SCHWARZE JACOBS & NADEL  
1601 MARKET ST., 36TH FLOOR  
PHILADELPHIA PA 19103

EXAMINER

WEINHARDT, R

ART UNIT

PAPER NUMBER

2761

DATE MAILED:

01/21/98

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Response to communication(s) filed on 8/28/95

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-70 is/are pending in the application.

Of the above, claim(s) is/are withdrawn from consideration.

☐ Claim(s) is/are allowed.

☒ Claim(s) 1-70 is/are rejected.

☐ Claim(s) is/are objected to.

☐ Claims are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received:

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

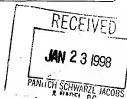
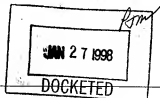
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 4

☐ Interview Summary, PTO-413

PTO-4 Draftsperson's Patent Drawing Review, PTO-948

Application, PTO-152

SEE OFFICE ACTION ON THE FOLLOWING



Art Unit: 2761

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-70 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicant argues that "a computer or other programmable apparatus whose actions are directed by a computer program or other form of 'software' is a statutory 'machine', and that a series of specific operational steps to be performed on or with the aid of a computer is a statutory 'process'". However, according to the final version of the Guidelines, a programmed computer is not automatically statutory as suggested by applicant.

In accordance with section IV/B/2/(a)/(ii) of the final version of the Guidelines, claims to specific machines or specific article of manufacture are statutory. Claims that define a computer related invention as a specific machine or specific article of manufacture must define the physical structure of the machine or manufacture in terms of its hardware or hardware and "specific software". However, the means recited in the claims are supported by a disclosure that states "one skilled in the art will recognize

Art Unit: 2761

that the computer system 10 may be any computer system having the ability to perform the functions to be described below". See page 5 of the instant specification. Also, no specific software is disclosed in support of the recited means. Thus, the system claims do not explicitly recite any specific hardware or specific software. As a result, the system claims represent claims that encompass any machine embodying the process recited and must be considered on the basis of the underlying process. See section IV/B/2/(a)/(I).

As noted above, applicant has argued that a series of operational steps performed on or with a computer is a statutory process. However, claim 54, for example, does not include a recitation of a computer and thus is not within the technological arts. Moreover, according to section IV/B/2/(b) it is not always the case that such computer performed steps are statutory. To be statutory, a claimed computer-related process must either: (1) result in the physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan or (2) be limited by the language in the claim to a practical application within the technological arts.

With respect to the recited methods and the underlying methods of the recited systems, no physical transformation is found as no pre- or post- computer process activity is recited. The result of the method and system claims is a report of the

Art Unit: 2761

solution. This merely conveys the direct result of the computer operation, which does not render the claims statutory. See section IV/B/2/(d)/(iii). Further, no practical application within the technological arts appears in the claim language. Again, the result is merely the reporting of the solution. The solution is not applied, as no purchasing or booking of trips in the travel scheme of the solution occurs, for example. The dependent claims only serve to either further define the variables used in the algorithm, the data gathering used to collect the variables, the algorithm itself or the arrangement of the output.


In light of the above, the claims are drawn to non-statutory subject matter.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Weinhardt whose telephone number is (703) 305-9780. The examiner can normally be reached on Monday-Friday from 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes, can be reached on (703) 305-9711. Facsimile transmissions to this Group may be directed to (703) 308-5356 or 5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

January 19, 1998

  
ROBERT A. WEINHARDT  
PRIMARY EXAMINER

Art Unit: 2761

\*\*\*\*\*  
**IMPORTANT NOTICE**  
\*\*\*\*\*

Effective November 16, 1997, the Examiner handling this application will be assigned to a new Art Unit as a result of the consolidation into Technology Center 2700. See the forth coming Official Gazette notice dated November 11, 1997. For any written or facsimile communication submitted **ON OR AFTER** November 16, 1997, this Examiner, who was assigned to Art Unit 2411, will be assigned to Art Unit **2761**. Please include the new Art Unit in the caption or heading of any communication submitted after the November 16, 1997 date. Your cooperation in this matter will assist in the timely processing of the submission and is appreciated by the Office.

